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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,537	07/11/2003	Jeffrey L. Armstrong	043210-1541-00	3505
23409	7590	07/30/2004	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			HURLEY, KEVIN	
		ART UNIT	PAPER NUMBER	
		3611		

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/617,537	ARMSTRONG ET AL.	
Examiner	<b>Art Unit</b>		
Kevin Hurley	3611		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_\_.  
2a)  This action is **FINAL**.                    2b)  This action is non-final.  
3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 9-16 and 21-28 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 9-16 and 21-28 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 11 July 2003 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All    b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I, claims 9-16 (and new claims 21-28) in the reply filed on 21 June 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "contoured wall portion" (claim 9), "attachment point" (claim 9) "exposed portion" (claim 11), "upper portion" (claim 12), "lower portion" (claim 12).

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "contoured wall portion" (claim 9), "attachment point" (claim 9) "exposed portion" (claim 11), "upper portion" (claim 12), "lower portion" (claim 12). must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures

appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The claims include the use of the word "for" which indicates intended use. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647

(Bd. Pat. App. & Inter. 1987).

If Applicant(s) desire to give the phrase patentable weight, the Examiner respectfully recommends Applicant(s) remove “for” from the phrase where intended use is not desired.

6. The use of the phrase “adapted” has been noted in the claims. It has been held that the recitation that an element is “adapted” is not a positive limitation but only requires the ability to perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138 (CCPA 1946).

7. Claims 9-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Thurm.

Thurm discloses a cover for a motorcycle oil tank assembly including an exposed surface, an inlet having an inlet aperture, and an oil cap removably engaged with the inlet and substantially sealing the inlet aperture, the cover composing:

a contoured wall portion 32 defining an inner surface and an attachment point 16 adapted to collect the contoured wall to the oil tank such that the inner surface is facing the exposed surface and the contoured wall portion substantially covers the exposed surface of the oil tank., wherein the contoured wall portion includes an aperture 34 adapted to allow access to at least a portion of the oil cap when the contoured wall is attached to the oil tank, wherein the contoured wall portion includes an exposed portion, an upper portion, and a lower portion, the attachment point located on one of the upper portion and the lower portion , further comprising a second attachment point 14, wherein the attachment point is located on the upper portion and the second attachment point is located on the lower portion, further comprising at least one additional

attachment point 800 located on each of the upper portion and the lower portion, wherein each attachment point is a protrusion, wherein the contoured wall portion is substantially formed from a metallic material.

8. Claim 21 is a product by process claim. Product-by Process claims are not limited to the manipulations of the recited steps, only the structure implied. See MPEP 2113. “[E]ven though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

9. Claims 21, 24-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Thurm.

Thurm discloses a motorcycle comprising:

- a frame;
- a front wheel coupled to the frame;
- a rear wheel coupled to the frame;
- an engine coupled to the frame and adapted to propel the motorcycle;
- an oil tank 32 (note the term “oil tank” has been interpreted as meaning a tank with the intended use of being filled with oil) coupled to the frame and adapted to contain oil used to lubricate the engine, the oil tank having an exposed surface, an inlet having an inlet aperture 36, and an oil cap 38 removably engaged with the inlet and substantially sealing the inlet aperture;

and a cover 12 including a contoured wall portion defining an inner surface, and an attachment point 16 adapted to connect the contoured wall to the oil tank such that the inner surface is facing the exposed surface and the contoured wall portion substantially covers the exposed surface of the oil tank,

wherein the cover is substantially formed from a metallic material, wherein the cover is supported by the oil tank, wherein the oil tank includes a first attachment surface 38 and a second attachment surface 40, each of the attachment surfaces including at least one tank attachment member, and wherein the cover includes a first cover surface and a second cover surface, each of the cover surfaces including at least one cover attachment member 16, the cover attachment members engaged with the tank attachment members to attach the cover to the oil tank, wherein each of the tank attachment members is a projection and wherein the corresponding cover attachment member is a recess.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 22-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Thurm in view of Natsume JP 07-291169.

Thurm discloses the claimed invention except the tank is not made of plastic.

It is known in the art, as taught by Natsume, to form a motorcycle tank of plastic as it is

light weight and resistant to dents.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Thurm, by forming the tank from plastic, in view of Natsume, in order to provide a tank that is light weight and resistant to dents.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bonardi discloses a plastic motorcycle tank. The other cited art disclose covers for motorcycle tanks.

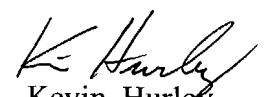
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Hurley whose telephone number is 703-308-0233. The examiner can normally be reached on Monday-Friday 9:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703-308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Kevin Hurley  
Primary Examiner  
Art Unit 3611

July 28, 2004